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| 09/748,196      | 12/27/2000  | Yumiko Ouchi         | 045070-5032         | 2964             |

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EXAMINER

FINEMAN, LEE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2872

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/748,196

Applicant(s)

OUCHI, YUMIKO

Examiner

Lee Fineman

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. Figures 10 and 11 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. ✓

### *Specification*

3. The disclosure is objected to because of the following informalities:

On page 26, lines 17 and 19 the deflection mirror incorrectly has reference numeral "24" and should be --23--.

On page 27, line 21 the field lens incorrectly has reference numeral "29" and should be --27--.

On page 32, line 15 there is just the letter "s," which should be --as--.

On page 39, line 15 there is the word "mage," which should be --image--.

Appropriate correction is required.

***Claim Objections***

4. Claims 1-2, 4-9, and 10 are objected to because of the following informalities:

In claim 1, line 21 there is insufficient antecedent basis for the limitation "said selected lens," as it could be either the selected objective lens or the selected condenser lens. ✓

In claims 1 and 2, lines 11-12, the language "can be selected" is ambiguous and does not give a positive recitation of the claim. Therefore the limitation does not clearly set forth the metes and bounds of the claim. ✓

The dependent claims inherit the deficiencies of the claims from which they depend.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-2, 4-5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Osa et al., U.S. Patent No. 6,396,628.

Regarding claim 1, Osa et al. discloses a stereomicroscope (fig. 6) comprising an illumination unit (LH) for illuminating a specimen (S) with light, a specimen setting board (not numbered, fig. 30), a fitting member (T) for fitting an objective lens (31), the illumination unit,

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specimen setting board and fitting member are disposed in sequence on an optical axis (fig. 30), wherein one of a predetermined low-magnification objective lens and a higher-magnification objective lens than the low-magnification objective lens (column 16, lines 39-40) is selected and fitted as the objective lens to the fitting member, the illumination unit includes a light source (20), a shield element (40a, 40b) for cutting off partially light beam emitted from the light source, first and second condenser lenses for converging the light beam passing the shield element on the specimen and a mechanism for selecting one of the first and second condenser lenses and disposing the selected condenser lens on the optical axis (26, column 15, lines 33-40), the first condenser lens exhibits an optical characteristic of setting a position conjugate to an entrance pupil of the low-magnification objective lens fitted to the fitting member in a position of the shield element or in the vicinity of the shield element and the second condenser lens exhibits an optical characteristic of setting a position conjugate to an entrance pupil of the high-magnification objective lens fitted to the fitting member in a position of the shield element or in the vicinity of the shield element (fig 34, column 19, lines 36-49).

Regarding claim 2, Osa et al. further discloses a first condenser lens for converging the light beam passing the shield element on the specimen and a mechanism for moving the first condenser lenses on and off the optical axis (26, column 15, lines 14-16), the shield element is disposed in a position of an entrance pupil or in the vicinity of the entrance pupil of the high-magnification objective lens as the objective lens fitted to the fitting member and the first condenser lens exhibits an optical characteristic of setting a position conjugate to an entrance pupil of the low-magnification objective lens fitted to the fitting member in a position of the shield element or in the vicinity of the shield element (fig 33, column 18, lines 41-48).

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Regarding claims 4, 7 and 8, Osa et al. further discloses the illumination unit including a collector lens (21, fig. 30) disposed between said light source and said shield element and the collector lens forms an image of the light source in a position of the shield element (column 14, lines 64-67, column 15, lines 1-4), and a reflecting element for bending the optical axis (24) disposed between the shield element and the first or second condenser lens (fig. 30). Osa et al. also discloses the shield element including a stretchable light shield member and a mechanism for stretching and contracting the light shield member (figs 25A & B, 26A & B, column 12, lines 27-59) in at least so far as stretchable is defined as to extend in length.

Regarding claim 5, Osa et al. further discloses a reflecting element for bending the optical axis (430, fig 39A) disposed in the position of the shield element (435) of the illumination unit (300) and the shield element has a cover member (column 25, lines 14-21) for covering a part a reflecting surface of the reflecting element.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osa et al.

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Regarding claim 3, Osa et al. further discloses a zoom-stereomicroscope where the shield element is disposed in a position conjugate to the entrance pupil or in the vicinity of the entrance pupil of the objective lens exhibits the lowest magnification (column 24, lines 14-19) but the reference does not explicitly state a zoom lens including a movable lens movable in a direction of the optical axis in order to change a magnification. Official notice is taken that it is well known to one of ordinary skill in the art at the time the invention was made that a conventional zoom system includes a zoom lens with a movable lens movable in a direction of the optical axis in order to change a magnification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention that the zoom-stereomicroscope of Osa et al. includes a zoom lens with a movable lens movable in a direction of the optical axis in order to change a magnification in that this system is readily available and can be easily obtained for use in manufacturing.

Regarding claim 6, Osa et al. discloses the claimed invention except for the shield element including a mechanism for increasing and decreasing a covered area of the reflecting surface by feeding out and drawing in the cover member above the reflective surface in order to adjust a quantity of the light beam to be cut off (i.e. retractable). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the shield element retractable, since it has been held that adjustability, where needed, and having a recognized need for the adjustment involves only routine skill in the art. One would have been motivated to make the shield element retractable for the purpose of quickly and easily moving the shield element from the path of light. *In re Stevens*, 212 F.2d 197, 101 USPQ 284 (CCPA 1954).

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Regarding claim 9, Osa et al. discloses the claimed invention except for the converging angle of the light beam converged by the second condenser lens being larger than the aperture angle of the high-magnification objective lens. Official notice is taken that systems have a larger converging angle of the light beam than the aperture angle are well known to one having ordinary skill in the art at the time the invention was made in order to avoid wasted light in the system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made have to have the converging angle of the light beam converged by the second condenser lens being larger than the aperture angle of the high-magnification objective lens to avoid wasting light.

Regarding claim 10, Osa et al. discloses the claimed invention except where a reflectance of the front end portion of the cover member is larger than the reflectance of other portions thereof. In another embodiment, Osa et al. teaches a shield element (figs. 18A and 23A) wherein the front end portion (45b) causes a reflectance that is larger than the reflectance of other portions thereof (45a, 40a, column 11, lines 58-67 and column 12, lines 1-5). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the shield element as the cover member to increase the degree of freedom of illumination and more finely control the contrast.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

LAF  
July 1, 2002



**Cassandra Spyrou**  
**Supervisory Patent Examiner**  
**Technology Center 2800**